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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

LI et al.

Atty. Ref.: 2824-9

Serial No. 09/145,180

Group: 1617

Filed: September 1, 1998

Examiner: Wang, S.

For: OXO-SUBSTITUTED COMPOUNDS, PROCESS OF MAKING, AND
COMPOSITIONS AND METHODS FOR INHIBITING PARP ACTIVITY

#27
#KID
10-3-02

* * * * *

September 24, 2002

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE

Responsive to the Official Action dated May 24, 2002, entry and consideration of the following remarks are requested.

The Section 103 rejection of claims 184-192, 207, 209-213 and 216 over Weltin in view of Banasik, Suto, and Endres, is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following further distinguishing comments.

The applicants submit that the Examiner has failed to establish a prima facie case of obviousness.

First, the Examiner is urged to appreciate that a prima facie case of obviousness may only be established where there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Even if the

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combination of the references teach every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious is improper. MPEP 2143.01; *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner states that Suto et al discloses nitro and/or amino substitution at the 5 position of a dihydroisoquinolinones (p.109, Table I). The Examiner also states that Banasik et al. teaches a 2-nitro-6(5H)-phenanthridinone which has greater inhibition than 6(5H)-phenanthridinone (Weltin et al. However, the Examiner fails to explain where the suggestion or motivation to combine is derived and merely states, “since optimization of PARP inhibiting activity of isoquinoline derivatives by amino and/or nitro substituents is known in the art, a person with ordinary skill in the art would have been reasonably expected to optimize of PARP inhibiting activity of 6(5H)-phenanthridinone by adding amino and/or nitro group to 6(5H)-phenanthridinone.” The art fails to provide the requisite motivation or suggestion to combine the cited art to establish a prima facie case of obviousness. The mere fact that the teachings of the prior art can be modified or combined does not establish a motivation or suggestion to combine and make the resultant combination prima facie obvious. MPEP 2143.01. Although “amino and/or nitro substituents is known in the art,” a person with ordinary skill in the art cannot reasonably be expected to optimize PARP activity in such a way without suggestion or motivation to do so. The prior art must suggest the desirability of the combination which has not been established here. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Thus, the Examiner has not met the burden of establishing a prima facie case of obviousness.

Withdrawal of the Section 103 rejection is requested.

The applicants acknowledge, with appreciation, the Examiner's indication that claim 196 contains allowable subject matter. The claims are submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



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Atty Dkt. 2824-9

LI et al.

C# M#

Serial No. 09/145,180

Group Art Unit: 1617

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Examiner: Wang, S.

Date: September 24, 2002

Title: OXO-SUBSTITUTED COMPOUNDS, PROCESS OF MAKING, AND
COMPOSITIONS AND METHODS FOR INHIBITING PARP ACTIVITYAssistant Commissioner for Patents
Washington, DC 202311617
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TECH CENTER 1600/2900

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment 0 minus highest number
previously paid for 20 (at least 20) = 0 x \$ 18.00 \$ 0.00

Independent claims after amendment 0 minus highest number
previously paid for 3 (at least 3) = 0 x \$ 84.00 \$ 0.00

If proper multiple dependent claims now added for first time, add \$280.00 (ignore improper) \$ 0.00

Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s) (\$110.00/1 month; \$400.00/2 months; \$920.00/3 months) \$ 110.00

Terminal disclaimer enclosed, add \$ 110.00 \$

☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$740.00) \$ 0.00

☐ Please enter the previously unentered , filed

☐ Submission attached

Subtotal \$ 110.00

If "small entity," then enter half (1/2) of subtotal and subtract -\$ 55.00

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00) \$ 0.00

Assignment Recording Fee (\$40.00) \$ 0.00

Other: One-month Extension Fee 0.00

TOTAL FEE ENCLOSED \$ 55.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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By Atty: B. J. Sadoff, Reg. No. 36,663

Signature: 